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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,723	07/31/2003	Qing Dai	ARC920000109US2	2803
23980	7590	08/31/2004	EXAMINER	
REED & EBERLE LLP 800 MENLO AVENUE, SUITE 210 MENLO PARK, CA 94025			ZUCKER, PAUL A	
			ART UNIT	PAPER NUMBER

1621

DATE MAILED: 08/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

## Application No.

10/632,723

## Applicant(s)

DAI ET AL.

## Examiner

Paul A. Zucker

## Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13 is/are allowed.
- 6) ☒ Claim(s) 20 and 21 is/are rejected.
- 7) ☒ Claim(s) 14-19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/31/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
2. The disclosure is objected to because of the following informalities: Applicants should amend the first sentence of the specification to reflect the issuance of the parent application 09/759,117 as US 6,638,662. Appropriate correction is required.
3. Applicants are advised that, according to Rule 1.126, beginning with the second claim 13, claims 13-20 have been renumbered to claims 14-21, respectively. The renumbered claims are used in the Office Action below,

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 15 and 16 recite the limitation "the extraction". There is insufficient antecedent basis for this limitation in the claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Doan et al (Journal of the American Chemical Society, Dimerization of Carboxylic Acids and Salts: An IR Study in Perfluoropolyether Medias, 1997, 119 (41), pages 9810-9815). Doan discloses (Page 9811, column 1, 2<sup>nd</sup>-4<sup>th</sup> full paragraphs) the sodium salts of the commercially available Demnum, Krytox and Fromblin perfluoropolyether carboxylic acids. A compound is characterized by its atoms and bonds and not its method of manufacture. Doan therefore anticipates claims 20 and 21.

***Claim Objections***

6. Claims 14-21 are objected to because of the following informalities: Applicants should ensure that all claim dependencies are amended to reflect the renumbering under Rule 1.126. Appropriate correction is required.

***Allowable Subject Matter***

7. Claims 1-13 are allowed. Claims 14-19 are drawn to allowable subject matter. The following is a statement of reasons for the indication of allowable subject matter:  
Doan, the closest prior art, neither teaches nor fairly suggests the instantly claimed method for preparing a metal salt of a perfluorinated polyether. Doan teaches (Page

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9811, column 1, 2<sup>nd</sup>-4<sup>th</sup> full paragraphs) the use of sodium hydroxide solution to convert perfluorinated polyether carboxylic acids to their corresponding metal carboxylates but does not suggest the use of a salt of a volatile organic acid for the purpose. The instantly claimed method is therefore patentable over the teaching of Doan.

### ***Conclusion***

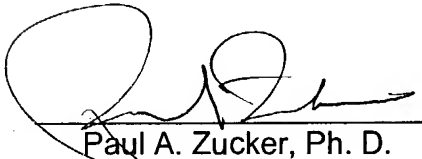
8. Claims 1-21 are pending. Claims 20 and 21 are rejected. Claims 14-19 are objected to. Claims 1-13 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Paul A. Zucker', is written over a horizontal line.

Paul A. Zucker, Ph. D.  
Patent Examiner  
Technology Center 1600